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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,194	01/22/2004	Chang-Chin Lai	LAIC3028/EM	2335

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EXAMINER	
PATEL, FAHD	
ART UNIT	**PAPER NUMBER**
2194	

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/761,194	LAI, CHANG-CHIN	
	Examiner	Art Unit	
	Fahd Patel	2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4 and 7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 4, 7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 4, 7 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 7 and claim 1 directly contradict each other. Amended claim 1 specifically recites that the memory device is a "portable disk having a USB connector". Applicant specifically describes what is well known in the art as a USB drive. However, USB drives are "dumb" drives that do not contain microprocessors. They are simply memory that is accessed using a particular connector. It is therefore impossible to claim both that the memory device is a USB drive and also that it consists of a microprocessor, as claim 7 discloses.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Shmueli et al. (hereafter Shmueli).

7. As per claim 1 Shmueli teaches:

installing an application in a memory device in advance (10, Fig. 1; p. 2, par. 0029);

connecting the memory device to an electronic device prior to use (p. 3, par. 0034);

automatically copying the application as a linked shortcut in an OS of the electronic device (p. 5, par. 0047, 0049);

showing an icon of the shortcut on a screen of the electronic device (86, Fig. 5); and

clicking the icon for opening the application, thereby enabling the electronic device to run the application (p. 5, par. 0049-0050).

wherein the memory device is a portable disk having a USB connector so that the memory device is adapted to connect to the electronic device having a USB port by inserting the USB connector into the USB port (Fig. 2A); and

wherein the electronic device is a notebook computer having at least one USB port so that the memory device may connect to the electronic device (p. 2, par. 0027-0028).

8. As per claim 7, Shmueli teaches that the memory device further comprises a microprocessor and, prior to the step of automatically copying, the microprocessor determines if the memory device is connected to the electronic device (p. 8, ¶ 0098).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shmueli, and further in view of Yang et al. (U.S PG Pub 2003/0110371 A1), hereafter Yang.

11. As per claim 4, Shmueli teaches that responsive to connecting the memory device to the electronic device, the application automatically copies itself as a linked shortcut in the OS of the electronic device, the icon of the shortcut is shown on the screen of the electronic device, and the electronic device is enabled to run the application (see rejection to claim 1 above). Shmueli does not specifically teach an autorun feature.

12. Yang teaches that the application has an embedded autorun (p. 2, par. 0015).

13. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the autorun feature from Yang with Shmueli's invention. Both inventions deal with interaction between an electronic device and a memory device. The ability to automatically run the program from a memory device adds to the convenience and ease of use of the invention, which is a valuable motivation (Yang, p. 1, par. 0005; Shmueli, p. 1, par. 0004).

Response to Arguments

14. Applicant's arguments filed 5/16/2006 have been fully considered but they are not persuasive.

15. As per claim 1, Applicant argues that the Shmueli reference is not analogous because it only invokes software that is already on the host instead of running software from the memory device. Coupled with that, Applicant argues that the launch bar serves only to launch the host application and does not equate to the shortcut in the instant invention. Applicant's interpretation of the prior art is selective and does not include all embodiments of the invention. In Shmueli's invention, "keylets" are executable programs on the memory device (52, 54, 56, Fig. 4) that are executed from the launch bar on the host. Indeed, Shmueli specifically states, "In the preferred embodiment, the launch button is the only way to launch the various keylets..." (p. 5, ¶ 0051), and "**The launching bar 76 may act as an interface to the various functions provided by the keylets on the key 10**." (p. 5, ¶ 0050). It is therefore clear that the

launch button is equivalent to the shortcut to a memory device application as claimed in the instant invention.

16. As per claim 4, Applicant's arguments are frivolous since the original Office Action specifically states the respective portions of the claim taught by Shmueli and Yang and the motivation to combine. Applicant treats the rejection as though it were rejected by Yang alone.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is the same which was disclosed in the original office action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fahd Patel whose telephone number is (571) 272-1044. The examiner can normally be reached on 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Thompson can be reached on (571) 272-3718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FHP

WILLIAM THOMSON
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